

The examiner states that if the alleged new matter is deleted, the previous rejection will apply. The previous rejection cites Schmid U.S. 4,717,502 as an anticipation of claim language reciting an optical brightener arranged on the outer side of the first coating layer, because Schmid discloses an optical brightener throughout the coating layer. The amendment was therefore an attempt to define more clearly over Schmid without departing from the disclosed subject matter.

The rejection under 35 U.S.C. §112 is traversed, because the specification describes the subject matter in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed.

First, as taught by Schmid and acknowledged in applicants specification at page 3, it is well known to add a brightener to the coating composition when it is in aqueous form, and is distributed throughout the coating together with binders, pigments, and dispersing agents. As discussed in applicants' specification at page 3, the problem with distributing brightener throughout the coating, is that it requires the addition of carrier substances such as starches, CMC, an polyvinyl alcohol. These substances are referred to by Schmid as secondary binders. A problem with such carrier substances is their high viscosity. See specification at page 3, lines 15-17.

From the foregoing it is apparent that the present application recognizes a problem with having brighteners throughout the coating layer, so one skilled in the art could not possibly conclude that the invention relates to brighteners throughout the coating layer.

Second, it is also clear that optical brightener is arranged on the outer side of a coating layer. See the summary at page 4, lines 12, where it states that "the optical brightener is arranged on the outer side of a coating layer".

So, one skilled in the art already knows, that the brightener is not throughout the coating layer but is on the surface. This is precisely what applicants presently claim, so the application as filed meets the written description requirement.

Third, the passage pointed out by the examiner says nothing different. Quoted in full, it reads as follows:

The arrangement of the optical brightener on the outer side of the coating layer encompasses that it is arranged both on the outer side of the coating layer and in the outer layer under the outer side. The porosity of the coating layer, which is always present, is appropriate even after a preceding calendering operation brings about this arrangement...

Thus, while the examiner correctly concludes that "in the outer layer under the outer side" reads on the brightener being within the coatings, it certainly does not suggest that the brightener is throughout the coating. Rather, it simply points out that the porosity of the coating layer will result in some of the brightener penetrating the layer. It defines what is meant by brightener being present only on the outer side of the coating layer.

Finally, the method steps recite drying the coating layer before applying an aqueous solution containing the brightener, before drying the aqueous solution. One skilled in the art knows that these steps will not result in brightener throughout the coating layer.

The CCPA has described the written description requirement as follows: "It is not necessary that the application describe the claim limitations exactly. ...but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations. In re Wertheim, 191 USPQ 90 (CCPA 1976). This case also requires that the examiner present evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. See MPEP §2163.04.

Satisfaction of the "written description" requirement does not require *in haec verba* antecedence in the original application. Stachelin v. Secher, 24 USPQ 2d 1513 (B.P.A.I. 1992).

Adequate written description under the first paragraph of 35 USC §112 does not require *literal* support for the claimed invention... Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed. Ex parte Parks, 30 USPQ 2d 1234 (B.P.A.I. 1994).


Based on the cited passages in the specification, it is believed that the application as filed reasonably conveys the concepts of the invention as presently claimed to one of ordinary skill in the art. This is all that the extensive case law in the area requires.

For all the foregoing reasons it is felt that the rejection under 35 U.S.C. §112 should be withdrawn and the application allowed.

Marked up changes to the claims which were submitted in the last amendment are attached hereto.

It is believed that no fees or charges are required at this time in connection with the present application; however, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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